

### **REMARKS/ARGUMENTS**

This Amendment is filed in response to the Office Action dated February 3, 2009. In the Office Action, Claim 1-19 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-14, 18, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Published Patent Application 2005/0104716 to Simms et al. (“*Simms*”). Claims 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Simms* in view of U.S. Published Patent Application 2004/0211834 to Fleckenstein et al. (“*Fleckenstein*”). The listed rejections are addressed below. For the Examiner’s reference, Claims 20-86 were previously withdrawn in response to a restriction requirement. In the current Amendment, Applicants have amended Claims 1-3, 7, 9-14, 16, 17, and 19 and have cancelled Claims 4-6. Thus, Claims 1-4 and 7-19 remaining pending for the Examiner’s consideration in the current application.

#### **Claim Rejections under 35 U.S.C. § 101**

On Page 2 of the Office Action, Claims 1-19 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner has stated that “in order for a method to be considered a ‘process’ under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials).”

In response, Applicants have amended Claims 1-19 to recite specific apparatus within the features of the claims. For instance, Applicants have amended Claim 1 to recite such steps as “using a computer system over the Internet to register a customer with an alternate delivery location (ADL) service provider..,” and “retrieving the ADL from the memory for use in shipping the product to the customer upon notification to the computer system by a vendor computer system over the Internet that the customer has purchased the product.” Applicants have also amended the remaining claims to recite apparatus, such as Claim 7 which recites “the customer providing the computer system identification information of at least one retriever

authorized by the customer to pick up the product at the ADL and the computer system storing the identification information in the memory.”

Thus, the method recited in Claims 1-19 is tied to another statutory class (i.e., identifies the apparatus that accomplishes the method steps), and therefore is considered a “process” under § 101. Accordingly, Applicants respectfully submit that Claims 1-19 are directed to statutory subject matter and respectfully request the Examiner to withdraw the rejection of Claims 1-19 under 35 U.S.C. § 101.

Claim Rejections under 35 U.S.C. § 102(b)

Claims 1-14, 18, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Simms*. The rejection of each claim is addressed below.

Independent Claim 1

On Page 3 of the Office Action, Claim 1 was rejected as being anticipated by *Simms*. Applicants respectfully submit that *Simms* does not teach or suggest each and every element of amended Claim 1. For example, amended Claim 1 recites the step of receiving the product purchased by the customer and shipped via a carrier not associated with the ADL service provider at the ADL for pickup by the customer.

*Simms* describes a system and a method for providing an appliance for delivery at a home or business (i.e., delivery site) when no one is available at the delivery site. *See* Abstract. The appliance is a locked storage container connected to remote computers such that access for a particular delivery person is authorized when the owner of the appliance has placed an order for delivery. *Id.*

For instance, the owner of the appliance places an order over the Internet to purchase a good for home delivery. *See* ¶ [0033]. In response, the retailer notifies a scheduler program residing on the remote computers that the good is to be delivered to the owner. *See* ¶ [0036]. The scheduler program notifies the appliance about the delivery and informs the appliance to provide access to particular delivery personnel. *See* ¶ [0038]. The delivery personnel delivers the good to the delivery site and places the good in the appliance by using some type of access

mechanism (such as an electronic key or a smart card). See ¶¶ [0030] and [0036]. Since the appliance has been informed to provide access to the particular delivery personnel, the appliance “unlocks” and allows the personnel to place the good in the appliance for safe keeping until the owner retrieves the good. *Id.*

Thus, the system and method described in *Simms* involves “the customer being linked to a website/retail partner **20** which in turn is linked to a scheduler website software **22** and delivery partner **24**.” See ¶ [0032]. “The delivery partner **24** in turn is linked to website/retail partner **20** and also to the customer’s home delivery attendant **26**.” *Id.* These links may be via the Internet, telephone, or other type of link. *Id.* As a result, a relationship must exist between these components (i.e., customer, website/retail partner, scheduler website software, and delivery partner) in order for the system and method of *Simms* to work. See FIG. 2. For instance, the deliver partner must be linked to the scheduler and must have the correct access mechanism to gain access to a customer’s attendant. This can limited the number of delivery options that can used in *Simms*.

However, such a restriction is not required in Claim 1. Claim 1 provides an ADL that can be used to delivery a product **shipped via a carrier not associated with the ADL service provider**. Thus, the carrier selected by either the customer and/or the vendor is independent of the ADL service provider. As a result, any number of carriers may be used to ship the product to the ADL and the customer and/or the vendor are not required to use a carrier on a restricted list such as is the case in *Simms*.

Furthermore, amended Claim 1 recites additional features that are not taught or suggested in *Simms*. For example, Claim 1 recites providing the ADL to the vender computer system to use as a shipping location for the product purchased by the customer. In *Simms*, the customer notifies the scheduler of the purchase and the scheduler coordinates the delivery of the product. See ¶¶ [0046] to [0048]. Thus, *Simms* has no reason to provide the delivery location to the seller.

For these reasons, Applicants respectfully submit that *Simms* fail to teach or suggest each and every element recited in independent Claim 1. Accordingly, Applicants respectfully request that the Examiner withdraw the current rejection of Claim 1 under § 102(b).

Appl. No.: 10/696,180  
Amdt. dated May 4, 2009  
Reply to Office Action of February 3, 2009

Dependent Claims 2-14, 18 and 19

On Page 3 of the Office Action, Claims 2-24, 18, and 19 were rejected as being anticipated by *Simms*. These claims depend from independent Claim 1 and therefore include all the elements of Claim 1 plus additional elements that further define the invention over the prior art. Accordingly, for at least the reasons set forth above in regard to independent Claim 1, Applicants respectfully assert that these claims are also in condition for allowance.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Simms* in view of *Fleckenstein*. These claims depend from independent Claim 1 and therefore include all the elements of Claim 1 plus additional elements that further define the invention over the prior art. Accordingly, for at least the reasons set forth above in regard to independent Claim 1, Applicants respectfully assert that these claims are also in condition for allowance.

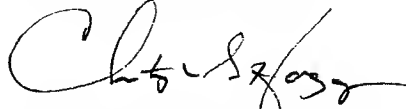
Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed February 3, 2009. The foregoing amendments when taken in conjunction with the appended remarks, is believed to have placed the present application in condition for allowance, and such action is respectfully requested. The Examiner is encouraged to contact Applicants' undersigned attorney at (404) 881-7640 or e-mail at [chris.haggerty@alston.com](mailto:chris.haggerty@alston.com) to resolve any remaining issues to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Appl. No.: 10/696,180  
Amdt. dated May 4, 2009  
Reply to Office Action of February 3, 2009

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Chris Haggerty', with a stylized flourish at the end.

Christopher S. Haggerty  
Registration No. 58,100

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Atlanta Office (404) 881-7000  
Fax Atlanta Office (404) 881-7777

**ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON May 4, 2009.**